

### **REMARKS/ARGUMENTS**

The Office Action dated September 23, 2003 has been carefully reviewed, and these remarks are responsive thereto. Applicants respectfully request reconsideration and allowance of this application.

Claims 1-11, 17-28, and 30-37 remain pending and new claims 38-48 are newly added in this application. Claims 12-16 and 29 are canceled without prejudice or disclaimer. Independent claims 1, 17, 28, 30, and 34 have been amended to recite use of past dates and/or historical prices in creating the portfolios. Support for these changes is evident, for example, from items 202 and 205 in Figs. 2A and 2B, from items 511 and 603 in Figs. 5 and 6, from items 903 and 1003 in Figs. 9 and 10, and from the corresponding description of these items in the original specification. New claims 38-41, 43-46, and 48 are based on claims 1, 2, 6, 7, 17, 18, 22, 23, and 28, respectively, but the new claims are in somewhat different format and scope. Support for new claims 42 and 47 may be found, for example, at page 7, lines 18-21 and page 8, lines 19-21 in the original specification. No new matter is included in this Amendment. The additional claim fees due as a result of this Amendment may be charged to the undersigned's Deposit Account, Deposit Account No. 19-0733. A separate Fee Transmittal paper is included with this filing.

Applicants extend their sincere thanks to Examiner Poinvil for the courtesy extended to their representative during the personal interview conducted December 16, 2003 and for his helpful comments during the interview. The content of this Amendment generally reflects subject matter discussed during the interview, and the subject matter of the interview also is identified in more detail below.

#### **I. CLAIMS 1-11, 17-28, AND 30-37 PATENTABLY DISTINGUISH FROM WALLMAN**

The Office rejected claims 1, 2, 17, 18, and 28-37 under 35 U.S.C. § 102(e) as allegedly anticipated by Wallman, U.S. Patent No. 6,360,210 (hereinafter "Wallman"). Additionally, claims 3-16 and 19-27 were rejected as allegedly obvious (35 U.S.C. § 103(a)) based on the Wallman patent. Applicants respectfully traverse these rejections and request reconsideration.

While Applicants do not agree or admit that the Office's rejections based on Wallman are proper, in order to expedite prosecution and to facilitate allowance of this application, various amendments have been made to certain independent claims in this application. For example, Applicants have amended claims 1 and 17 to recite receipt of input indicating a past date for purchase of the portfolio and calculation of the portfolio's past performance based on this past date. Claim 28 is amended to recite an input system for receiving a historical price associated with each issue and a processor for determining past performance data relating to the portfolio based on the historical price. Additionally, claims 30 and 34 have been amended to recite receipt of a past closing date for the issues, receipt of historical prices for the issues based on the past closing date, and creation of the portfolio based, at least in part, on the historical prices. Applicants respectfully submit that nothing in Wallman teaches or remotely suggests these features of the amended claims.

During the personal interview, Examiner Poinvil agreed that Wallman did not appear to describe these features of Applicants' invention.

Accordingly, Applicants respectfully submit that claims 1-11, 17-28, and 30-37 patentably distinguish from the system, method, and computer-readable medium disclosed in Wallman. Withdrawal of these rejections and allowance of these claims are earnestly solicited.

## **II. THE CLAIMS DEFINE STATUTORY SUBJECT MATTER**

The Office rejected claims 1-37 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter, namely, as directed to "an abstract idea." Applicants respectfully traverse these rejections and request reconsideration.

While Applicants do not agree or admit that the Office's 35 U.S.C. § 101 rejections are proper, in order to expedite prosecution and to facilitate allowance of this application, various amendments have been made to certain independent claims in this application. For example, claims 1 and 34 have been amended to clarify that the method includes receipt of computer inputs and that the portfolio creation is performed by a computer. During the December 16, 2003, interview, the Examiner indicated that changes of this type would overcome the rejections of these claims based on 35 U.S.C. § 101.

Regarding claims 17, 28, 30, and their associated dependent claims, during the interview, the Examiner indicated that the § 101 rejections of these claims were not proper and that the rejections should be withdrawn in the next Office Action.

In view of the foregoing, Applicants respectfully request withdrawal of the rejections based on 35 U.S.C. § 101.

### **III. NEW CLAIMS 38-48 PATENTABLY DISTINGUISH FROM WALLMAN**

The Wallman patent relates to methods and systems that enable investors to seek prices for and purchase insurance, in an effort to manage the risk associated with a particular investment portfolio. Once a user enters all of the relevant information relating to the portfolio for which insurance is being considered (*e.g.*, the list of assets/liabilities, their values, the number of shares or percentage of shares in the portfolio, the level of insurance desired etc.; see Wallman at column 6, lines 14-19), the portfolio information is sent to one or more third parties who may then produce insurance package bids for the portfolio to the investor. The investor can then determine whether he/she wishes to purchase an insurance package.

Regarding new claims 38 and 43, these claims recite receiving input identifying issues to be added to a portfolio, receiving input including a selection of one of plural options for creating the portfolio, and creating the portfolio based on the identified issues and the selected option. Applicants respectfully submit that nothing in Wallman teaches or suggests these claimed features, and particularly, nothing in Wallman teaches or suggests selection of one of plural options for creating the portfolio.

Claims 42 and 47 depend from claims 38 and 43, respectively, and these claims further recite retrieving current issue price information relating to the specific issues, and additionally using the retrieved current issue price information when creating the portfolio. Applicants respectfully submit that nothing in Wallman teaches or remotely suggests the additional features of these dependent claims.

With regard to new claim 48, this claim relates to a system for creating a portfolio of issues. The claim recites an input for receiving a designation of issues and an option for creating

the portfolio of the specified issues selected from a plurality of options, and a processor for automatically retrieving a price associated with each of said issues and for determining the number of shares of said issues to add to the portfolio based on the designated option and the price. Applicants respectfully submit that nothing in Wallman teaches or suggests this combination of features.

Accordingly, Applicants respectfully submit that new claims 38-48 patentably distinguish from the system, method, and computer-readable medium disclosed in Wallman. Allowance of these new claims is earnestly solicited.

#### IV. CONCLUSION

A separate Fee Transmittal paper accompanies this submission. However, if that paper is missing, or if any fees are required that are not accounted for in that paper, such as fees under 37 C.F.R. §§ 1.16 or 1.17, or if an additional extension of time is necessary that is not accounted for in the papers filed with this Amendment, the Commissioner is authorized to debit our Deposit Account No. 19-0733 for any necessary fees, including any necessary extension fees.

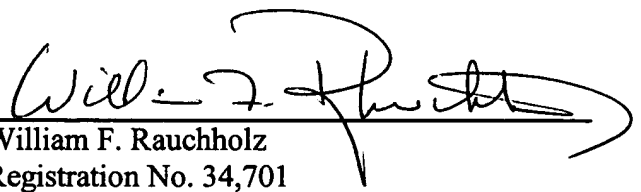
All rejections having been addressed, Applicants respectfully submit that this application is in condition for immediate allowance and respectfully solicit prompt notification of the same.

Respectfully submitted,

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